

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

5 APPLICANT: PREECE EXAMINER: Cumming
SERIAL NO.: 10/617,074 GROUP: 2683
FILED: July 10, 2003 CASE NO.: CS22227RA
10 ENTITLED: OBTAINING SERVICE WHEN IN A NO-COVERAGE AREA OF A
COMMUNICATION SYSTEM

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20 APPEAL BRIEF UNDER 37 C.F.R. § 41.37

MS Appeal Brief - Patents
Commissioner for Patents
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Sir:

30 Applicant submits the present Appeal Brief in accordance with 37 C.F.R. § 41.37 and
in response to the correspondence dated May 5, 2007.

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I. REAL PARTY IN INTEREST

The real party in interest is, Motorola, Inc.

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II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

10 **III. STATUS OF CLAIMS**

Claims 1-8 and 15-26 are pending. Claims 1-8 and 15-20 are rejected and are the subject of the present appeal.

15 **IV. STATUS OF AMENDMENTS**

An Amendment After Final Rejection was filed on January 18, 2006. The amendments to the claims were denied entry by the February 8, 2006 Advisory Action.

20 **V. SUMMARY OF CLAIMED SUBJECT MATTER**

Detailed below are the two independent claims on appeal. The third independent Claim 21 and its dependent Claims 22-26 are not on Appeal and have been indicated as allowable.

The inventions, as set forth in Claims 1 and 15, are generally drawn to obtaining service when in a no-coverage area (11) of a communication system (page 1, lines 7-8). If a mobile station (10) enters a no-coverage area (11), information of a last known available communication system can be used to obtain service from the last known available communication system (Figs. 1 and 2, page 4, lines 12-22 and Fig. 3, page 6, lines 16-28).

30

Claim 1. A method (a flow chart of the method is shown in Fig. 3) for obtaining service when in a no-coverage area (item 11, Fig. 1) of a radiotelephone communication system (page 6, lines 18 and 19, Fig. 3), the method comprising the steps of:

storing (Fig. 3, page 6, lines 20-23) information regarding a last known

5 available communication system (32);

reporting (Fig. 3, page 6, lines 23-27) the information about the last known available communication system to a user of the radiotelephone (34); and

using (Fig. 3, page 6, lines 27 and 28) the information to obtain service from the last known available communication system (36).

10

Claim 15. A mobile radiotelephone (item 10, Figs. 1 and 2) operable to obtain service when in a no-coverage area (item 11, Fig. 1) of a communication network (item 18, Figs. 1 and 2, page 3, lines 22-24), the radiotelephone (10) comprising:

a user interface (24);

15

a memory (26);
a processor (22) coupled to the user interface (24) and the memory (26), the processor (22) controls radio communication circuitry for communication with the communication network (18), wherein the processor (22) stores information regarding the last known available service from the communication network (18) in the memory (26) and reports this information to a user of the radiotelephone (10) through the user interface (24) when the radiotelephone (10) is in a no-coverage area (item 11, Fig. 1), such that the user can use this information to obtain service from the last known available communication network (item 18, Figs. 1 and 2, page 4, lines 9-11).

For further detail and context for Claim 15, see page 4, line 12 through page 6, line 17.

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VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

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1. Whether the drawings show every feature of the invention specified in the claims.
2. Whether claims 1-20 are allowable under 35 U.S.C. § 112, first paragraph for enabling one of ordinary skill in the art to make and/or use the invention.
- 10 3. Whether claims 5 and 8 are allowable under 35 U.S.C. §112, first paragraph as complying with the written description requirement.
4. Whether claims 1-20 are allowable under 35 U.S.C. § 112, second paragraph as being definite for particularly pointing out and distinctly claiming the subject matter which the applicant regards as the invention.
- 15 5. Whether claims 1-20 are allowable under 35 U.S.C. §101 for being operative and having utility.

VII. ARGUMENT

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Claim Limitations At Issue

- In Claim 1, the limitations at issue are italicized below:
- 25 1. A method for obtaining service when in a no-coverage area of a radiotelephone communication system, the method comprising the steps of:
storing information regarding a last known available communication system;
reporting the information about the last known available communication system to a user of the radiotelephone; and
30 *using the information to obtain service from the last known available communication system.*

In Claim 15, the limitations at issue are italicized below:

15. A mobile radiotelephone operable to obtain service when in a no-coverage area of a communication network, the radiotelephone comprising:

5 a user interface;

 a memory;

 a processor coupled to the user interface and the memory, the processor controls radio communication circuitry for communication with the communication network, wherein the processor stores information regarding the last known available service from the communication network in the memory and reports this information to a user of the 10 radiotelephone through the user interface when the radiotelephone is in a no-coverage area, such that the user can use this information to obtain service from the last known available communication network.

Applicants' Argument

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The Office Action objects to the drawings. These objections are respectfully traversed. The Office Action alleges the drawings must show every feature of the invention specified in the claims and that the location system independent of the communication as stated by claim 5 and location broadcast network access points as stated in claim 8 must be shown or the features canceled from the claims. Applicant disagrees. Applicant asserts claims 5 and 8 are method claims. The features in these method claims are reciting steps in a method. The steps are illustrated in Fig. 5, elements 50 and 60. Thus, the claimed method steps are illustrated in the drawings.

Accordingly, Applicants respectfully request withdrawal of the objection to the drawings.

20 The Office Action rejects claims 1-20 under 35 U.S.C. § 112, first paragraph for not enabling one of ordinary skill in the art to make and/or use the invention. This rejection is respectfully traversed. The Office Action alleges the specification fails to provide an enabling disclosure on how a user with a radio telephone in a no-coverage area can obtain service from a radio telephone system since the radio telephone is still in the no-coverage area of that radio telephone system. Applicant disagrees. In particular, none of the claims recite obtaining service while a radio telephone is "still" in a no-coverage area. More particularly, the claims

expressly recite a method performed while in a no-coverage area. The elements of the method are used to obtain service.

Furthermore, there is no recitation of a step of actually obtaining service in the no-coverage area. Again, the preamble expressly recites the method is performed while in a no-
5 coverage area. To elaborate, the method recites steps performed in the no-coverage area that can be used to obtain service. There is no step of actually obtaining service when the radiotelephone is still in the no-coverage area.

The Office Action goes on to allege "returning the radio telephone to the coverage area to obtain service is critical or essential to the practice of the invention, but not included in the claim(s)." Applicant disagrees. Applicant asserts there is no statutory basis for reciting a "critical or essential" element in a claim and such is not required by 35 U.S.C. §112, first paragraph. Therefore, the Office Action has not provided a proper ground of rejection.
10 Furthermore, Applicant asserts the steps in claim 15 inform a user in a no-coverage area on how to obtain coverage. The user may disregard the information and not return to a coverage area.
15

Accordingly, Applicant requests the withdrawal of the rejection of claims 1 and 15 under 35 U.S.C. §112, first paragraph.

The Office Action rejects claims 5 and 8 under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. Applicants disagree. Initially, Applicants assert the Office Action does not indicate how the claims do not comply with the written description requirement. The Office Action only uses template language and a conclusory remark that the claims contain subject matter which was not described in the specification. The Office Action does not indicate which features are not described and why the features are not described. Regardless, regarding claim 5, page 7, lines 5-8 support the claimed feature. Regarding claim 8, page 8, lines 22-29 support the claimed feature.
20 Furthermore, "There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed" (*In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976)). The Office Action has provided no evidence to overcome the presumption.
25

Accordingly, Applicant requests the withdrawal of the rejection of claims 5 and 8 under 35 U.S.C. §112 first paragraph.

The Office Action rejects claims 1-20 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. This rejection is respectfully traversed.

5 The Office Action alleges claims 1, 9 and 15 "are confusing since obtaining service from a no-coverage area of a radiotelephone system (sic). By definition, a no coverage area does not have any service." Applicants respectfully disagree. As discussed above, claims 1 and 15 recite a method performed while in a no-coverage area. This method can allow the radio telephone to obtain service. There is no step of actually having service while still in the no-coverage area. The claims recite the steps of a method performed in the area that can be
10 used to obtain service. Thus, the claims particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

15 The Office Action alleges the term "a communication system" is confusing since there is a third type of communication system now, the "too far away" communication system in claims 7, 14, and 20. Applicants agree there is a third term for a communication system and the Office Action correctly indicates the third term for the communication system is a "communication system that is too far away." In particular, the third term is distinguished from the others by the additional feature of "too far away." Therefore the claims are clear.

Accordingly, Applicants request withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

20 The Office Action rejects, under 35 U.S.C. §101, claims 1-20 for being inoperative and lacking utility because it is impossible to obtain service from a no-coverage area of a radiotelephone system since by definition a no coverage area does not have any service. This rejection is respectfully traversed. Applicants assert the claims have utility by being a method performed in a no-coverage area that provides information for obtaining service. As
25 discussed above, the claims expressly recite a method performed while in a no-coverage area. The method is used to obtain service. There is no recitation of a step of actually obtaining service in the no-coverage area. Again, the preamble expressly recites the method is performed while in a no-coverage area. To elaborate, the method recites steps performed in the no-coverage area that can be used to obtain service. Therefore, the claims are operative and have utility. Accordingly, Applicant requests the withdrawal of the rejection of claim 1-
30 20 under 35 U.S.C. §101.

Furthermore, Applicant asserts the Office Action does not give the pending claims their broadest reasonable interpretation, as required by MPEP § 2111. In particular, in

accordance with MPEP § 2111, "During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000)." However, the Office Action does not give the pending claims their broadest reasonable interpretation, as required by 5 MPEP § 2111. As discussed above, claims 1 and 15 recite a method performed while in a no-coverage area. This method can allow the radio telephone to obtain service. There is no step of actually having service while still in the no-coverage area and such is an unreasonable interpretation of the claims. In particular, the claims clearly recite the steps of a method performed in the area that can be used to obtain service. Thus, the Office Action does not 10 give the pending claims their broadest reasonable interpretation, as required by MPEP § 2111 and the rejections are improper.

Applicant further asserts the Office Action does not give the pending claims an interpretation consistent with the specification, as required by MPEP § 2111. Again, as 15 discussed above, claims 1 and 15 recite a method performed while in a no-coverage area and this interpretation is consistent with the specification. However, the Office Action does not give the pending claims an interpretation consistent with the specification, as required by MPEP § 2111, and the rejections are improper.

Applicants also assert the Office Action does not interpret the claims in a manner consistent with the interpretation that those skilled in the art would reach. In particular, 20 MPEP § 2111 requires the "broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)." As discussed above, claims 1 and 15 recite a method performed while in a no-coverage area. There is no step of actually having service while still in the no-coverage area and such is neither claimed nor provided by the 25 specification. The claims recite the steps of a method performed in the area that can be used to obtain service, such as by returning to the last known available communication system. This interpretation is consistent with the interpretation that those skilled in the art would reach. Thus, the Office Action does not interpret the claims in a manner consistent with the interpretation that those skilled in the art would reach, as required by MPEP § 2111, and the 30 rejections are improper.

Furthermore, Applicant asserts the final Office Action does not even attempt to substantively respond to Applicant's arguments. In particular, the final Office Action contains many pages of language copied from the MPEP. The final Office Action only makes specific

reference to Applicant's claims and arguments on pages 22 and 23 where it alleges "Applicant's attorney remarks seems to the examiner that one person wrote the specification, one person [wrote] the claims and another person wrote the arguments and all these persons did not even read each other works at all." However, Applicant does not understand how such 5 a statement relates to the allowability of the claims. Furthermore, Applicant asserts that statement does not address the substance of Applicant's arguments.

The final Office Action goes on to allege "Applicant's attorney has not explain how 'when in a no-coverage area of a radiotelephone communication system' and then 'obtain service from the last known available communication system.'" Applicant disagrees. In 10 particular, Applicant asserts Applicant provided numerous arguments as to why the claims are allowable and the final Office Action does not even bother to address the substance of the arguments. Because the final Office Action apparently cannot address the substance of Applicant's arguments, Applicant asserts the arguments are persuasive and the application is in condition for allowance.

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CONCLUSION

In view of the discussion above, the claims of the present application are in condition 20 for allowance. Kindly withdraw any rejections and objections and allow this application to issue as a United States Patent without further delay.

The Commissioner is hereby authorized to deduct the fees for filing a brief in support of an appeal and any fees arising as a result of this Appeal Brief or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

5

Respectfully submitted,

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VIII. CLAIMS APPENDIX

1. A method for obtaining service when in a no-coverage area of a radiotelephone communication system, the method comprising the steps of:

5 storing information regarding a last known available communication system;
 reporting the information about the last known available communication system to a user of the radiotelephone; and
 using the information to obtain service from the last known available communication system.

10 2. The method of claim 1, wherein the information in the storing step includes recording information about a time since the radiotelephone was last in contact with the last known available communication system, and wherein the reporting step includes reporting the time information to the user.

15 3. The method of claim 1, wherein the information in the storing step includes recording information about a location where the radiotelephone was last in contact with the last known available communication system, and wherein the reporting step includes reporting the location information to the user.

20 4. The method of claim 3, further comprising determining directional information to the location from the storing step, and wherein the reporting step includes reporting the directional information to a user to follow to obtain service from the last known available communication system.

5. The method of claim 1, wherein the storing step includes determining a location of the last known available communication system using a location system independent of the last known available communication system itself.

5 6. The method of claim 1, further comprising estimating that a loss of service from the last known available communication system is imminent, and wherein the storing step includes using information from the last known available communication system to determine a location of available service before service is lost from the last known available communication system.

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7. The method of claim 1, further comprising a step of detecting signals from a communication system that is too far away for two-way communication with the radiotelephone, and the reporting step includes reporting to the user whether a strongest of such signals is from the last known available communication system.

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8. The method of claim 1, further comprising a step of detecting signals from location-broadcasting network access points of the last known available communication system that are too far away for two-way communication with the radiotelephone, and wherein the storing step includes recording the broadcasted locations of network access points 20 from the detecting step, and wherein the reporting step includes reporting the broadcasted locations of the network access points from the detecting step to the user.

9-14. (canceled)

15. A mobile radiotelephone operable to obtain service when in a no-coverage area of a communication network, the radiotelephone comprising:

a user interface;

a memory;

5 a processor coupled to the user interface and the memory, the processor controls radio communication circuitry for communication with the communication network, wherein the processor stores information regarding the last known available service from the communication network in the memory and reports this information to a user of the radiotelephone through the user interface when the radiotelephone is in a no-coverage area, 10 such that the user can use this information to obtain service from the last known available communication network.

15. 16. The radiotelephone of claim 15, wherein the information includes information about at least one of a time and location where the radiotelephone was last in contact with the communication network.

17. The radiotelephone of claim 15, wherein the processor calculates and displays directions on the user interface for a user to follow to obtain service from the communication network.

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18. The radiotelephone of claim 15, wherein the processor estimates when a loss of service from a communication network is imminent, communicates with the communication network to determine a location of available service before service is lost, and stores this location information in the memory for presentation on the user interface.

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19. The radiotelephone of claim 15, wherein when service is lost from the communication network, the processor determines information about at least one of a time and location where the radiotelephone was last in contact with the communication network and stores this information in the memory for presentation on the user interface.

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20. The radiotelephone of claim 15, wherein the processor detects signals from a communication system that is too far away for two-way communication with the radiotelephone, determines whether a strongest of such signals is from the communication network, and reports this information on the user interface.

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21. A method in a radiotelephone, the method comprising:
losing service from a communication system;
storing information regarding a last available service from the communication system;
15 reporting the information about the last available service from the communication system to a user; and
using the information to obtain service from the communication system.

22. The method according to claim 21, wherein the information in the storing step
20 includes recording information about a location where the radiotelephone was last in contact with the communication system.

25 23. The method according to claim 21, wherein the information in the storing step includes information about at least one of a time and location where the radiotelephone was last in contact with the communication system.

24. The method according to claim 21, further comprising determining directional information to the location from the storing step, and wherein the reporting step includes reporting the directional information to a user to follow to obtain service from the communication system.

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25. The method according to claim 21, further comprising estimating that a loss of service from a communication system is imminent, and wherein the storing step includes using information from the communication system to determine a location of available service before service is lost from the communication system.

10

15

26. The method according to claim 21, further comprising detecting signals from a communication system that is too far away for two-way communication with the radiotelephone, and the reporting step includes reporting to the user whether a strongest of such signals is from the communication system.

IX. EVIDENCE APPENDIX (not applicable)

None

5 X. RELATED PROCEEDINGS APPENDIX (not applicable)

None